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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/422,654	10/22/1999	JOSEPH H. MATTHEWS III	3797.84665	5815

28319 7590 01/28/2002

BANNER & WITCOFF LTD.,  
ATTORNEYS FOR MICROSOFT  
1001 G STREET, N.W.  
ELEVENTH STREET  
WASHINGTON, DC 20001-4597

EXAMINER

HUYNH, BA

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 01/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. <b>09/422,654</b>	Applicant(s) <b>Matthews III, et al</b>
	Examiner <b>Huynh-Ba</b>	Art Unit <b>2173</b>

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)  Responsive to communication(s) filed on Jan 21, 2002

2a)  This action is FINAL.      2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

**Disposition of Claims**

4)  Claim(s) 40-48 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 40-48 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.

12)  The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

**Attachment(s)**

15)  Notice of References Cited (PTO-892)  
 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_

19)  Notice of Informal Patent Application (PTO-152)

20)  Other: \_\_\_\_\_

*BA HUYNH*  
PRIMARY EXAMINER

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**DETAILED ACTION**

**Supplemental**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 40-48 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification as originally filed, fails to provide a detailed description of the now claimed limitation “each shape being separated from an adjacent shape by a spacing distance based on border parameters”, as recited in independent claim 40 and equivalently in claims 43 and 46. Contrarily, as seen in figures 15 and 17, each of the menu items are adjacent to each other and separated only by a dividing line. There is no spacial distance in between each of the menu items.

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***Claim Rejections - 35 USC § 103***

3. Claims 40-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over US patent #5,463,727 (Wiggins et al.) Rationales for the rejection continue to be as set forth in the previous Office action.

***Response to Arguments***

4. Applicant's arguments filed on 11/29/01 have been fully considered but they are not persuasive.

**REMARKS:**

In response to the argument that the limitation "a storage for storing a main menu comprising a list of menu option" is not inherently included in Wiggins et al, the main menu is disclosed in figure 1 (col. 3, lines 37-38). The main menu is disclosed in figure 1. In order for the main menu to be displayed on the screen, text and graphics associated with the main menu must be stored in a memory of the computer, thus the "storage for storing a main menu comprising a list of menu options" is inherently included in Wiggins et al. The applicants further argue that Wiggins discloses a ROM for storing programs to implement display of windows but not for storing a list of menu options. In response to the argument, windows are used for displaying different menu screens, one of the window is the main menu window 10 (col. 3, lines 19-24). Thus, within the context of figure 1, the terms "menu display screen" and "window" are used interchangeably.

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In response to the applicants' request of a secondary reference to support for the "inherently included" rationale, contrary to the "well known" analysis which can be challenged by requesting a secondary reference to support for the well known of a claimed limitation, "inherence" rationale implies that the claimed limitation is already within the reference, thus does not require a supporting secondary reference. The applicants request is therefore denied.

The applicants further argue that Wiggins does not teach each option resides in a shape and each shape being separated from adjacent shape by a spacing distance based on border parameter (the argument, page 5, first full par.). In response to the argument, each of the menu options 11-16 resides in a rectangular shape, wherein each shape being separated from adjacent shape by a spacing distance based on border parameter (figure 1).

In response to the argument that Wiggins does not teach the enlarging the shape of a selected menu option, the rectangular shape of menu option 16 is enlarged by an additional surrounding border 17. This is equivalent to the applicants' disclosure in figure 17.

The applicants provide the same arguments with respect to claims 43 and 46. The arguments have been fully responded to as set forth above.

### *Conclusion*

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Inquires**

Responses to this action should be mailed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 746-7238 may be used for formal After Final communications, (703) 746-7239 for Official communications, or (703) 746-7240 for Non-Official or draft communications. NOTE: A Request for Continuation (Rule 60 or 62) cannot be faxed.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huynh-Ba whose telephone number is (703) 305-9794. The examiner can normally be reached on Monday-Friday from 8.00AM to 4.30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca, can be reached on (703) 308-3116.

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All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

Huynh-Ba  
Primary Examiner  
Art Unit 2173

12/04/01

1/26/02

BA HUYNH  
PRIMARY EXAMINER